

ESTTA Tracking number: **ESTTA26349**

Filing date: **02/18/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### **Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

#### **Petitioner Information**

<b>Name</b>	Casa Tequilera De Arandas SA DE CV		
<b>Entity</b>	Corporation	<b>Citizenship</b>	Mexico
<b>Address</b>	6.4 Carretera Arandas-LeonRancho El Cabrito Arandas, Jalisco, 47180 MEXICO		

<b>Attorney information</b>	Adam K Sacharoff Much Shelist Freed Denenberg Ament & Rubenstein, PC 191 N Wacker Drive Suite 1800 Chicago, IL 60606 UNITED STATES asacharoff@muchshelist.com Phone:312-521-2775
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#### **Registration Subject to Cancellation**

<b>Registration No</b>	2791980	<b>Registration date</b>	12/09/2003
<b>Registrant</b>	Proalti S.A. de C.V. Blvd. Diaz Ordaz 1225-501 Colonia Las Reynas Irapuato, Guanajuato Z.C. 36660, MEXICO		
<b>Goods/Services Subject to Cancellation</b>	Class 033. First Use: 20030200, First Use In Commerce: 20030600 Goods/Services: ALCOHOLIC BEVERAGES, NAMELY, TEQUILA		

<b>Attachments</b>	Notice.pdf ( 4 pages )
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<b>Signature</b>	/aks/
<b>Name</b>	Adam K Sacharoff
<b>Date</b>	02/18/2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Registration of:

Registrant: Proalti S.A. de C.V.

Registration No: 2,791,980

Date of Issue: December 9, 2003

Mark: DON DIEGO SANTA

Casa Tequilera De Arandas SA DE CV

Petitioner,

v.

Proalti S.A. de C.V. KM

Registrant.

Cancellation No.:

PETITION FOR CANCELLATION

Petitioner, Casa Tequilera De Arandas SA DE CV KM (herein after "Casa Tequilera") a Mexican corporation with a mailing address of 6.5 Carretera Arandas-Leon, Rancho El Cabrito, Arandas, Jalisco, Mexico 47180 believes that it is and will continue to be damaged by Registration No. 2,791,980, and hereby petitions to cancel same.

To the best of Petitioner's knowledge, the name and address of the current owner of the registration is Proalti S.A. de C.V. a Mexican Corporation Blvd. Diaz Ordaz 1225-501 Colonia Las Reynas Irapuato, Guanajuato Z.C. 3660 Mexico.

As grounds for this Petition, Casa Tequilera, alleges:

1. Registrant obtained a registration (Registration No. 2,791,980) for DON DIEGO SANTA for "alcoholic beverages, namely, tequila in International Class 33 on December 9, 2003 pursuant to Lanham Act Section 1(b) based on use of the mark in commerce since July 2003.
2. Petitioner is engaged in the business of making and selling tequila.
3. Petitioner owns the application to register the mark DON DIEGO for tequila and mezcal in International Class 33 pursuant to Lanham Act Section 1(b) based on an intent to use the mark, which application has been assigned application Serial No. 78/124,953.

4. Petitioner has received an Office Action dated June 22, 2004, refusing registration of its DON DIEGO mark (Serial No. 78/124,953) based on a likelihood of confusion with Registrant's registration for DON DIEGO SANTA (Registration No. 2,791,980, under Section 2(d)).

5. Petitioner is in the process of reinstating its application and requesting a suspension pending the outcome of this cancellation proceeding.

6. Petitioner is and will continue to be injured and damaged by the existence of Registration No. 2,791,980 because said registration is preventing Petitioner from obtaining its own registration. Registration No. 2,791,980 permits Registrant to retain the presumption of an exclusive right to the trademark DON DIEGO SANTA for tequila in International Class 32, and thereby casts a cloud upon Petitioner's right to use the mark DON DIEGO on its own products in the United States, especially as the registration for DON DIEGO SANTA for tequila has been cited as a basis for rejecting Petitioner's application for DON DIEGO for tequila and mezcal in International Class 33.

7. Petitioner believes, and therefore alleges, that Registrant's mark DON DIEGO SANTA has been abandoned and is not, and during at least the last two years has not been, used in any manner in interstate commerce.

8. An Internet search has not revealed any articles that refer to Registrant's brand of tequila. An Internet search on the Registrant's name reveals that the single reference to the company is an expired domain address:

Send E-Mail to **PROALTI, SA DE CV**

PARA / TO: **PROALTI, SA DE CV**. E-Mail: [proalti@prodigy.net.mx](mailto:proalti@prodigy.net.mx), Nombre/Name, E-mail, Empresa/Company, Telefono/Phone, Fax, Comentarios/Comments.

[www.guanajuatoexport.com/Includes/aspmail/fcontact.asp?id=303](http://www.guanajuatoexport.com/Includes/aspmail/fcontact.asp?id=303) - 8k - Supplemental Result - [Cached](#) - [Similar pages](#)

9. A close evaluation of the specimen filed in the Registration reveals that the tequila is produced and bottled by Tequilas del Senor SA de Cv and imported by Falcon Busto Importers Inc. A review of the manufacturer's website [www.tequilasdelsenor.com.mx](http://www.tequilasdelsenor.com.mx) including the products being produced by Tequilas del Senor did not show the brand DON DIEGO SANTA currently being produced. In addition, a review of the importers website [www.falconbustoimporters.com/home.html](http://www.falconbustoimporters.com/home.html) did not show that the brand DON DIEGO SANTA was being imported. A telephone call to the number listed on-line for Falcon Busto Importers Inc. was not the companies telephone but a individual's cell phone.

10. Federal alcoholic beverage labeling law further supports Petitioner's allegations of abandonment. Pursuant to 27 C.F.R. §5.51 (a) distilled spirits shall not be released from Customs unless a certificate of label approval (COLA) is obtained from the Alcohol and Tobacco Tax & Trade Bureau (TTB). A search of TTB records reveals that Registrant applied for and was issued a COLA for a label bearing the DON DIEGO SANTA mark in 2002. However, no COLAs were issued for DON DIEGO SANTA labels after 2002. Sale of an alcoholic beverage whose label does not have a valid COLA is a per se violation of the Federal Alcohol Administration Act. Therefore, it is highly likely that Registrant has not lawfully sold tequila with the DON DIEGO SANTA mark in commerce since 2002.

11. Petitioner believes, and therefore alleges that because it will be harmed as result of the Office's finding of likelihood of consumer confusion between the parties' respective marks pursuant to Section 2(d) and because of Registrant's abandonment of its rights in the mark DON DIEGO SANTA, Petitioner is entitled to the exclusive right to use DON DIEGO in commerce and the right to registration thereof. If Registrant is permitted to maintain its invalid registration, it will raise doubts as to Petitioner's right to use the mark DON DIEGO. Said registration would therefore cause damage to Petitioner.

WHOREFORE, Petitioner prays that Registration No. 2,791,980 for DON DIEGO SANTA be cancelled and that this Petitioned for Cancellation be sustained in favor of Petitioner.

A duplicate copy of this Petition is enclosed herewith, along with a check for \$300.00 for the applicable filing fee.

Respectfully submitted,

Date: 02-18-2005

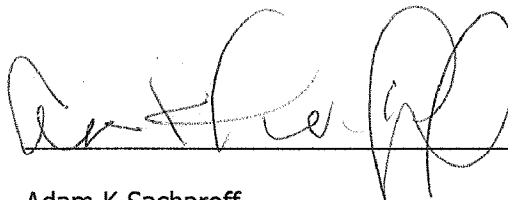
By:

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Adam K Sacharoff  
Attorney for Petitioner  
Casa Tequilera De Arandas SA DE CV

**CERTIFICATE OF EMAIL**

I hereby certify that this correspondence is being emailed to the United States Trademark Office  
on 02-18-2005.

A handwritten signature in black ink, appearing to read 'Adam K Sacharoff', written over a horizontal line.

Adam K Sacharoff